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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Application of:

Janne MIKKOLA

Serial No.: 10/590,841

Examiner: **Michael Y. Mapa**

Filed: **August 24, 2006**

Group Art Unit: 2617

For: **METHOD AND ARRANGEMENT FOR REDIRECTING DATA TO BE
TRANSFERRED TO A MOBILE STATION**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION TO WITHDRAW RESTRICTION REQUIREMENT

Sir:

This petition is filed under the provisions of 37 CFR 1.144 and 1.181 in response to the restriction requirement of September 26, 2008. The Applicant of the instant application respectfully requests a reconsideration of the restriction requirement established by the Office in an Office Action mailed October 15, 2008. It is believed that no fee under any sections of 37 CFR 1.17 is required for this Petition. However, in case if any fee is due, the U.S. Patent and Trademark Office is authorized to charge the fee deficiency to the Deposit Account No. 23-0442.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to:
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Lorraine F. Kniffin

Dated: Aug. 21, 2009

REMARKS

This petition is filed in response to the restriction requirement of September 26, 2008, reiterated in the non-final Office Action of January 16, 2009 and the final Office Action of June 18, 2009, following an election with traverse and a request for reconsideration, respectively.

In the original restriction requirement, the Office required that applicant elect one of the following two classes:

I. Claims 1-11 & 18-26, drawn to call diversion within the network level communication system and method, classified under class 455, subclass 417 & 561

II. Claims 12-17, drawn to call diversion within the mobile station, classified under class 455, subclass 417 & 550.1

In a response filed October 30, 2009, Applicant elected Group I with traverse. In the traversal, Applicant argued that the functionality of elements recited in the independent claims may locate in a mobile switching center, network terminal or network gateway bus, all of which are network elements in a mobile network, and that in each case the call diversion process according to the invention is executed within the network. The Office rejected the traversal of the Applicant, asserting that despite the fact that the claimed mobile station must be part of a mobile network, a “network level communication system” refers to a base station, mobile switching center, server or network elements not including the mobile station apparatus. In reply, the Applicant requested reconsideration on the ground that the mobile station as claimed in claims 12-17 has basically the same limitations as the other related claims and it is so closely related that it would not be an extra burden for the Examiner to examine the Group II claims, referring to § 603 of the MPEP where it states that if the search and examination of all the claims in an application can be made without a serious burden, the Examiner must examine them on the merits, even though they include claims to independent or distinct inventions. The Applicant argued that the Office failed to show it would create a serious burden. In reply, the Office asserted that it would be a serious burden on the Examiner because the claims fall under two different subclasses (455/561 and 455/550.1) and are directed towards diverging searches. Applicant still respectfully disagrees with the Office that the restriction is proper.

The MPEP, §803, sets forth two criteria for a proper requirement for restriction:

- (A) The inventions must be independent or distinct as claimed; **and**
- (B) There would be a serious burden on the examiner if restriction is not required.

The Office has failed to establish that the inventions of Group I and Group II meet both of these criteria.

In asserting that the restriction is proper, the Office appears to primarily rely on the fact that the inventions fall under different subclasses, and therefore, it would create a serious search burden. As stated above, the classification for the Group I claims is 455/417 and 455/561, and the classification for the Group II claims is 455/550.1. Class 455 is directed to telecommunications. Subclasses 550.1 and 561 both are subclasses of subclass 73, defined as “Transmitter and Receiver at Same Station (e.g., Transceiver).” The subclass is more specifically defined as “[s]ubject matter having both a signal transmitter and a signal receiver at a common geographic location for transmission and reception of separate signals.” Indented under subclass 73 is subclass 550.1, “Radiotelephone equipment detail,” which is defined as “[s]ubject matter wherein the transceiver is dedicated for two-way voice or data communication via a switched telephone network.” Lastly, indented under subclass 73 AND subclass 550.1 is subclass 561, “Base station detail,” specifically defined as “indented under subclass 550.1. Subject matter including a structural configuration detail of a mobile communication serving site.”

The classifications of the two groups should not serve as the sole basis for finding that the inventions are independent and distinct. By virtue of being a subclass of 550.1, subclass 561 is directed to subject matter including a structural configuration detail of a mobile communication serving site AND subject matter wherein the transceiver is dedicated for two-way voice or data communication via a switched telephone network (the subject matter of 550.1). Thus, according to the Office’s classification of Group I and Group II, Group I also includes some subject matter which falls under Group II.

Inventions as claimed are independent if there is no disclosed relationship between the inventions, that is, they are unconnected in design, operation, and effect. MPEP §806.6. The claims of Group I and Group II are connected in all three of these aspects. All of the claims are related to parts of a mobile network. As evidenced by the Office’s classifying all claims as being in a mobile network where there is a signal transmitter and a signal receiver at a common

geographic location for transmission and reception of separate signals and this transceiver is dedicated for two-way voice or data communication via a switched telephone network, the claims are clearly similar in design. Further, the fact that the independent claims in Group I and Group II have strong similarities shows that the claims are connected in operation and effect. For example, consider a comparison of method claim 1 (in Group I) and mobile station claim 12 (in Group II):

Claim 1: A method comprising:	Claim 12: A mobile station comprising a processor configured to:
	receive a call divert command that is defined in a transmitting mobile station, so that the mobile station receives data designated to said transmitting mobile station,
identifying a data transmitting device, from which data is being transmitted to a receiving station;	identify a data transmitting device, from which data is being transmitted to the mobile station,
in case the data transmitting device is identified as a transmitting device, from which there is defined a call divert command to the receiving mobile station, receiving the data; or	receive the data, in case the data transmitting device is identified as the transmitting mobile station, from which data, according to the call divert command, is transmitted to the mobile station, and
in case the data transmitting device is identified as other than the transmitting device, from which there is defined a call divert command to the receiving mobile station.	transmit the data further, in case the data transmitting device is identified as other than the transmitting mobile station, from which data, according to the call divert command, is transmitted to the mobile station.

Although claim 12 recites the additional feature of receiving the call divert command, these claims are nearly identical when compared side by side. Thus, it is clear that these two claims and two groups are connected in operation and effect and are not independent or distinct.

Furthermore, although the two groups are not independent, and for this reason alone, restriction is improper, Applicant also submits that the Office has failed to show that it would be a serious burden if restriction is not required. Although the two groups have been defined in different subclasses, as explained above, the two subclasses are overlapping. A search for an invention classified under classes 455/417 and 455/561 would result in subject matter which also falls under 455/417 and 455/550.1. Thus, it is quite possible that a search for an invention which

falls under subclasses 417 and 561 would find an invention which could also have been classified under 417 and 550.1.

Applicant respectfully disagrees with the Office where it states in the final Office Action of June 18, 2009, it “would be a serious burden on the examiner since both inventions are directed towards diverging searches (i.e. 455/561 (structural configuration detail of a mobile communication serving side) and 455/550.1 (configuration detail of a transceiver).” Given the strong similarities between the claims of Group I and Group II, Applicant does not believe it would be burdensome to examine all claims. Despite the Office’s statement that the burden of examining both groups stems from the diverging searches that would result from searching 455/550.1 and 455/561, an examination of the search notes and subsequent Office Actions (January 16, 2009 and June 18, 2009) shows that the Office believed all Group I claims could be rejected without even searching in 455/561. A search was conducted in 455/417, 379/207.02 and 379/211.01-213. If the sole difference between Groups I and II was the 550.1 and 561 subclassification, then there is no reason to believe the Office would have been burdened by examining both groups, when neither subclass was even searched. Even though the Office stated that the two searches would be required to show “structural configuration detail of a mobile communication serving site” and “configuration detail of a transceiver,” in rejecting the independent apparatus claim in Group I, mobile switching center claim 18 (the claim that it would have been necessary to search for the structural configuration), it was asserted that the claim was obvious under §103 because although the reference (Reding et al, U.S. Patent Application 2004/0156491) did not disclose “a mobile switching center,” it disclosed a network plane that included a mobile switching center. Although Applicant disagrees with the merits of the rejection and believes this claim is not obvious, it is very possible that had the Office examined the Group II claims, it would have applied the same logic and made the same exact rejection, as the same network plane (voice network 508 in Figure 5), which by comprising a mobile switching center is asserted to render obvious mobile switching center claim 18, also comprises a mobile station (114).

Therefore, Applicant respectfully submits that the Office has failed to establish that it would be a serious burden to examine all claims.

For the foregoing reasons, Applicant petitions that the restriction requirement be withdrawn.

Respectfully submitted,

A handwritten signature in black ink that reads "Francis J. Maguire". The signature is written in a cursive style with a large, looping initial "F".

Francis J. Maguire
Attorney for the Applicant
Registration No. 31,391

FJM/lk
WARE, FRESSOLA, VAN DER SLUYS
& ADOLPHSON LLP
755 Main Street, P.O. Box 224
Monroe, Connecticut 06468
(203) 261-1234